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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,901	03/26/2004	Hiraku Murayama	018961-068	7688
21839	7590	04/24/2006	EXAMINER	
BUCHANAN INGERSOLL PC (INCLUDING BURNS, DOANE, SWECKER & MATHIS) POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			HOEKSTRA, JEFFREY GERBEN	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/809,901	Applicant(s) MURAYAMA ET AL.	
	Examiner Jeffrey G. Hoekstra	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement(s) (IDS) submitted on 06/22/2004 is/are acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97 and 1.98. Accordingly, the examiner is considering the information disclosure statement(s).

Claim Objections

3. Claim 2 is objected to because of the following informalities: it is unclear if the recited "central portion" is structurally equivalent to the "center layer" recited in claim 1. Appropriate correction is required.

Double Patenting

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 1, 8, and 9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 12,-14 of copending Application No. 10/802,869. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims are merely a broader recitation of the current claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Cook et al (US 5,213,111).

8. For claim 1, Cook et al discloses a guidewire 10 comprising a distal end portion 16 and a main body portion 14, wherein said main body portion comprises a center layer 13 formed of a first material, a surface layer formed of a second material, and an

Art Unit: 3736

intermediate layer, the boundary between said center and surface layers, formed of a mixture of said first material and said second material (column 1 lines 43-58 and column 2 line 60 – column 3 line 59).

9. For claim 2, Cook et al discloses a guidewire wherein said distal end portion is formed of said first material, and is continuous with the center layer of said main body portion as best seen in Figures 1 and 5-8.

10. For claim 3, Cook et al discloses a guidewire comprising an intermediate portion 15 located between said distal end portion and said main body portion as best seen in Figures 1 and 5-8, wherein said intermediate portion comprises a center layer formed of said first material, and a surface layer formed of a mixture of said first material and said second material (column 1 lines 43-58 and column 2 line 60 – column 3 line 59).

11. For claim 4, Cook et al discloses a guidewire wherein said intermediate layer is formed of the mixture of said first material and said second material is decreased in the content of said first material toward said surface layer and increased in the content of said second material toward said surface layer (column 1 lines 43-58 and column 2 line 60 – column 3 line 59).

12. For claim 5, Cook et al discloses a guidewire wherein said first material is a first metallic material, e.g. a readily weldable material such as lead with a modulus of elasticity equal to approximately 14 Gpa, and said second material is a second metallic material, e.g. a shape memory material such as NiTi with a modulus of elasticity equal to approximately 28 Gpa, having a great modulus of elasticity than said first metallic

Art Unit: 3736

material (column 1 lines 43-58, column 2 lines 14-17, and column 2 line 60 – column 3 line 59).

13. For claim 6, Cook et al discloses a guidewire wherein said first material is a contrast metal, such as lead (column 3 lines 1-3).

14. For claim 7, Cook et al discloses a guidewire wherein said second material is a stainless steel (column 3 lines 50-52).

15. For claim 8, Cook et al discloses a guidewire 10 comprising a distal end portion 16, a main body portion 14, and an intermediate portion 15 located between said distal end portion and said main body portion, said intermediate portion comprises a center layer formed of a first material, and a surface layer formed of a mixture of said first material and a second material as best seen in Figures 1 and 5-8 (column 1 lines 43-58 and column 2 line 60 – column 3 line 59).

16. For claim 9, Cook et al discloses a guidewire 10 comprising a distal end portion 16 and a main body portion 14, wherein said main body portion comprises a center layer formed of a first material, a surface layer formed of a second material, and an intermediate layer formed of a mixture of said first material and said second material as best seen in Figures 1 and 5-8 (column 1 lines 43-58 and column 2 line 60 – column 3 line 59), said intermediate layer is increased in the content of said first material toward said center layer, wherein said first material is a first metallic material, e.g. a readily weldable material such as lead with a modulus of elasticity equal to approximately 14 Gpa, and said second material is a second metallic material, e.g. a shape memory material such as NiTi with a modulus of elasticity equal to approximately 28 Gpa, having

Art Unit: 3736

a great modulus of elasticity than said first metallic material (column 1 lines 43-58, column 2 lines 14-17, and column 2 line 60 – column 3 line 59).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday, 8:00 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGH



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